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| APPLICATION NO.                                      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/567,505   | 04/17/2006  | Yoshikazu Takashima  | 3712174-00520       | 8960             |
| 29175  | 7590        | 02/18/2010           | EXAMINER            |                  |
| K&L Gates LLP<br>P. O. BOX 1135<br>CHICAGO, IL 60690 |             |                      | JACKSON, JENISE E   |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2439                |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/567,505 | <b>Applicant(s)</b><br>TAKASHIMA ET AL. |  |
|                              | <b>Examiner</b><br>JENISE E. JACKSON | <b>Art Unit</b><br>2439                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 44-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 44-63 and 84 are rejected under 101 for claiming non-statutory subject matter. As per claim 44, "an information recording medium", the specification on page 24 discloses the recording medium can be a CD, FD, and MO all of these are software and software is non-statutory subject matter. The Applicant is urged to amend claim 44 to show how the information recording medium is executed within an apparatus. As per claim 84, "a computer program", is directed to non-statutory subject matter, because a computer program is merely software. The Applicant discloses on page 24 that the computer program is just a program. The Applicant is urged to amend claim 84 to show who the computer program is executed within the computer.

3. Claims 74 is rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation.

Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 64-69, 72-79, 82-86 are rejected under 35 U.S.C. 102(e) as being anticipated by Benaloh(2005/0065890).

3. As per claim 64, Benaloh discloses an information processing apparatus[DVD drive] for executing reproduction[i.e. DVD player program] of content stored in an information recording medium[DVD][0029, 0044], comprising: a unit key acquisition section for identifying a content management unit[i.e. partitions/clips, 0063-0064] including execution from content so as to acquire a unit key corresponding to the identified content management unit[0069-0070]; and a data processing section for decrypting encrypted data included in said content management unit by use of the unit key selected by said unit key acquisition section[0074].

4. As per claims 65, 75, Behaloh discloses wherein said unit key acquisition section is configured to detect content management unit switching on the basis of a management table in which unit setting unit information, content management unit identification information, and unit key identification information are related with each other and, in accordance with the detected information, execute applicable unit key change processing [0063-0064, 0065, 0074, 0078].

5. As per claims 66, 76, Benaloh discloses a renewal key information block processing section for executing said unit key acquisition processing by decrypting a renewal key information block that may be processed only with a key stored in an information processing apparatus having a legal content use right, said key being set in correspondence with said content management unit[0098-0102].

6. As per claims 67, 77, Benaloh discloses wherein said renewal key information block acquires from a networked server(i.e. provider)[0077, 0083].

7. As per claims 68, 78, Benaloh discloses an authentication processing section for executing authentication processing with a networked server, wherein, upon successful authentication, said unit key acquisition section acquires information necessary for content reproduction including a unit key from said server[0055, 0098-0102].

8. As per claim 69, 79, 86, Benaloh discloses a renewal key information block processing section for acquiring an authentication key to be applied to authentication processing with a networked server by decrypting a renewal key information block that may be processed only with a key set in correspondence with said content management unit and stored in an information processing apparatus having a legal content use right; and an authentication processing section for authenticating a server by applying the authentication key obtained by the processing by said renewal key information block processing section; wherein, upon successful authentication, said unit key acquisition section or said data processing section acquires information necessary for content reproduction including a unit key

from said server[0047, 0098-0102] .

9. As per claims 72, 82, Benaloh discloses wherein said data processing section receives operation control information[i.e. key specific to each content player can copy the content, key is device specific] corresponding to content stored in said information recording medium and, in accordance with control based on the received operation control information, copies said content stored in said information recording medium[0065-0066, 0068].

10. As per claims 73, 83, Benaloh discloses wherein said data processing section notifies information processing apparatus identifier [i.e. device key], receives operation control information corresponding to the notified identifier from said networked server, and, in accordance with control based on the received operation control information, reproduces or copies content stored in said information recording medium[0065-0068].

11. As per claims 74, 84, Benaloh discloses an information processing method for reproducing content or executing a program stored in an information recording medium, comprising: identifying a content management unit including execution from said content; selecting a unit key corresponding to the identified content management unit; and decrypting encrypted data included in said content management unit to perform content reproduction processing and program execution processing use of the selected unit key[0063-0064, 0069-0070, 0074].

12. As per claim 85, Benaloh discloses a server for providing a unit key to be applied to decryption of content to a reproducing apparatus for reproducing content stored in an information recording medium, comprising: a database storing a unit key corresponding to a content management unit; an authentication processing section for authenticating said reproducing apparatus; and a data processing section for providing said unit key upon successful authentication in said authentication processing section[0070-0071, 0074].

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 44-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang et al.(2008/0253734) in view of Getsin et al.(6,529, 949).

15. As per claim 44, Kang et al. discloses an information recording medium[i.e. information storage medium] storing content[0016, 0018], said information recording medium comprising a configuration in which a content management unit that is a data section area including a content reproduction section specification file[i.e. Playlist][ 0040, 0048, see fig. 9 sheet 6], Kang also discloses a data file[i.e. clip, see fig. 9, 0040].

16. Kang et al. is silent on wherein the data file included in said content management unit is stored as encrypted data based on an individual unit key corresponding to said content management unit. Getsin et al. discloses wherein the data file(i.e. clip) included in said content management unit is stored as encrypted data based on an individual unit key corresponding to said content management unit(see col. 31, lines 1-11, 18-23).

17. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a data file in said content management unit is stored as encrypted data based on an individual unit key corresponding to said content management unit of Getsin with Kang, because video content is often stored on media such as CD or DVD(see col. 3, lines 27-29 of Getsin). Once a vendor has

delivered such content to a customer the vendor loses control over product, and the product becomes hard to prevent a customer from copying(see col. 3, lines 31-35 of Getsin), the motivation to stored a key corresponding to said content management unit is that there is a method that allows the vendor to supplement and/or modify the content and could allow the vendor to limit a client's access to certain portions of the locally stored content(see col. 3, lines 52-55 of Getsin).

18. Same Motivation as above. As per claim 45, Kang et al discloses wherein at least some of content management units set in said information recording medium are units set in correspondence with title information and index information of each piece of content stored in said information recording medium[see fig. 9 sheet 9, 0018, 0040]. Kang is silent on a unique content management unit and a unit key corresponding thereto are determined on the basis of the selection of said title information and said index information. Getsin discloses a unique content management unit and a unit key corresponding thereto are determined on the basis of the selection of said title information and said index information(see col. 31, lines 1-11, 18-23).

19. As per claim 46, Kang discloses index information[i.e. reproduction program/movie object] are presentable to a user[0018, 0019, 0051]. Kang is silent on wherein said title information are presentable to a user. Getsin discloses wherein said title information are presentable to a user(see col. 31, lines 1-25, 30-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to include title information are presentable to a user of Getsin with Kang, the motivation is that each portion of a video can locked to a separate title, and a user can jump to a separate title to unlock with the key, thus each title/chapter of a video is protected using a key(see col. 31, lines 1-6, 18-25, 30-35).

20. Same Motivation as claim 44 above. As per claim 47, Kang et al. discloses wherein at least some of content management units set in said information recording medium are units that are set in correspondence with a plurality of content reproduction processing programs stored in said information



recording medium[see fig. 9 sheet 9, 0040, 0048]. Kang is silent on; however, Getsin discloses and a unique content management unit and a unit key corresponding thereto are determined on the basis of the determination of said plurality of content reproduction processing programs to be executed on a reproducing apparatus on which said information recording medium is loaded(see col. 31, lines 1-11, 18-23).

21. As per claim 48, Kang et al. discloses wherein at least some of content management units set in said information recording medium are units that are set in correspondence with a plurality of content reproduction section specification files[i.e. playlist, see fig. 9 sheet 9, 0040, 0048] stored in said information recording medium[0018]. Kang et al. is silent on; however, Getsin discloses a unique content management unit and a unit key corresponding thereto selected by said content reproduction processing program to be executed on a reproducing apparatus on which said information recording medium is loaded(see col. 31, lines 1-11, 18-23). It would have been obvious to one of ordinary skill in the art to include a unit key of Getsin with Kang's content reproduction section specification files, because this insures that each playlist will have an associated key, and thus each playlist will be protected from unauthorized copying.

22. As per claim 49, Kang discloses wherein at least some of content management units set in said information recording medium are units that are set in correspondence with clip files that are a plurality of content real data storage files stored in said information recording medium[0018-0020, 0045]. Getsin discloses a unique content management unit and a unit key corresponding thereto are selected by said content reproduction processing program to be executed on a reproducing apparatus on which said information recording medium is loaded(see col. 31, lines 1-11, 18-23). It would have been obvious to one of ordinary skill in the art to include a unit key of Getsin with Kang's clip files, because this insures that each clip will have an associated key, and thus each clip will be protected from unauthorized

copying.

23. As per claim 51, Kang discloses wherein at least some of content management units set in said information recording medium are configured as units including an application execution file and a content reproduction processing program stored in said information recording medium[0040, 0046, 0053].

24. As per claim 52, Kang discloses wherein at least some of content management units set in said information recording medium are configured as units including an application execution file, a content reproduction processing file, and an application resource file for use in the execution of said application execution file stored in said information recording medium[0040, 0045-0046, 0053].

25. As per claim 53, Kang discloses wherein some of content management units set in said information recording medium are configured as units including a content reproduction section specification file, an AV stream file as content real data to be referenced from said content reproduction section specification file, an application execution file, and an application resource file for use in the execution of said application execution file stored in said information recording medium[see fig. 9 sheet 9, 0040, 0045-0046, 0053].

26. Same Motivation as claim 45. As per claim 54, Kang discloses wherein a management table in which unit setting unit information, content management unit identification information[0044-0045].

Kang is silent on; however, Getsin et al. discloses and unit key identification information are related with each other as information forming each of said content management unit is stored(see col. 31, lines 1-23).

27. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kang et al.(2008/0253734) in view of Getsin et al(6,529,949) as applied to claim 44 above, and further in view of Behaloh(2005/0065890).

As per claim 50, Kang discloses wherein content management units set in said information recording medium include: a first unit including content real data stored in said information recording medium[0018]; and a second unit not including content real data but including an application execution file corresponding to an application index file stored in said information recording medium[0051]. Kang is silent on encryption keys. Getsin discloses a key for unlocking a clip(see col. 31, lines 18-23); however, is silent on whether the key is an encryption key. Behaloh discloses said first unit and said second unit including at least one of a data file(i.e. clip) encrypted by different unit keys[0063-0064, 0074]. It would have been obvious to one of ordinary skill in the art at the time of the invention to include encryption keys of Behaloh with Kang-Getsin, the motivation is that once the partitions have been defined one or more copies of each partition or clip is made to define multiple partition sets, each partition is uniquely identified, thus this is a more efficient method of protecting a clip[0061 of Behaloh].

28. Claims 55-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang in view of Getsin as applied to claim 44 above, and further in view of Kamperman et al(2006/0212400).

29. As per claim 55, Kang nor Getsin discloses wherein said information recording medium stores a status management table in which status information indicative whether each of said content management units is in network associated status is stored. Kamperman et al. discloses wherein said information recording medium stores a status management table in which status information indicative whether each of said content management units is in network associated status is stored[0060, 0086,

0088]. It would have been obvious to one of ordinary skill in the art the time of the invention to include a status management table in which the network associated status is stored of Kamperman with the Kang-Getsin combination, because when accessing digital content at home it is harder to control illegally redistributing of the content[0008 of Kamperman], the motivation to include the status of network is that an authorized domain such as that disclosed in Kamperman is that within the authorized domain content is protected[0009 of Kamperman].

30. Same Motivation as claim 55. As per claim 56, Kang discloses content management unit[see fig. 9 sheet 9]. Kang nor Getsin disclose wherein said status management table stores at least initial status information. Kamperman discloses wherein said status management table stores at least initial status information[0064-0066, 0086].

31. As per claim 57, Kang nor Getsin discloses; however, Kamperman discloses wherein said status management table stores initial status information and current status information[0066, 0082, 0086, 0088]. It would have been obvious to one of ordinary skill in the art at the time of the invention to include an initial status information and current status information of Kamperman with Kang-Getsin combination, the motivation is that the transferable right can be transferred outside one domain to a different domain[0082 of Kamperman].

32. As per claims 58-59, Kang discloses wherein content use management information table[see fig. 5]. Kang and Getsin are silent on storing restriction information[i.e. usage rights] associated with content. Kamperman discloses storing restriction information[i.e. usage rights][0066-0069]. It would be obvious to one of ordinary skill in the art at the time of the invention to include storing restriction information of Kamperman with the Kang-Getsin combination, the motivation is that usage rights authorizes a person to use a certain content right, and can also describe what a user is allowed to do with the content[0066 of Kamperman].

33. As per claim 60, Kang discloses wherein said content use management information table has information indicative that content is subject to control on the basis of externally obtainable operation control information[0045-0046].
34. As per claim 61, Kang discloses wherein said content use management information table includes information for specifying a server for obtaining said operation control information[0052-0053].
35. As per claim 62, Kang discloses original content(i.e. clips)[0016]. Kang and Getsin are silent on wherein said information recording medium stores content for streaming reproduction. Kamperman discloses wherein said information recording medium stores content for streaming reproduction. It would have been obvious to include streaming reproduction of Kamperman with Kang-Getsin combination, the motivation is that content can be received through a PC, and the source can be an internet connection, streaming provides content in real-time[0060 of Kamperman].
36. Same Motivation as claim 62. As per claim 63, Kang discloses original content[0016]. Kang and Getsin are silent on wherein said streaming reproduction has a different data format. Kamperman discloses wherein said streaming reproduction has different data format[0060].
37. Claims 70-71, 80-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benaloh(2005/0065890) in view of Kamperman et al(2006/0212400).
38. As per claim 70, Benaloh is silent on wherein said data processing section determines whether said content management unit is in network independent status or network associated status and executes content use control in accordance with a decision. Kamperman discloses wherein said data processing section determines whether said content management unit is in network associated status and executes content use control in accordance with a decision [0060, 0086, 0088]. It would have been obvious to one of ordinary skill in the art the time of the invention to include the network associated status of

Kamperman with the Benaloh, because when accessing digital content at home it is harder to control illegally redistributing of the content[0008 of Kamperman], the motivation to include the status of network is that an authorized domain such as that disclosed in Kamperman is that within the authorized domain content is protected[0009 of Kamperman].

39. As per claims 71, 81, Behaloh discloses wherein said content use control is executed on the basis of a content use management information table storing control information associated with use of each said content management unit[0063-0064, 0078].

40. Same Motivation as claim 70. As per claim 80, Behaloh does not disclose determining whether said content management unit is in network associated status and executing content use control in accordance with a decision. Kamperman discloses determining whether said content management unit is in network associated status and executing content use control in accordance with a decision[0060, 0066-0069, 0086, 0088].

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENISE E. JACKSON whose telephone number is (571)272-3791. The examiner can normally be reached on Increased Flex time, but generally in the office M-Fri(8-4:30)..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on (571) 272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2439

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

1/29/10

/J. E. J./

Examiner, Art Unit 2439

/Edan Orgad/

Supervisory Patent Examiner, Art Unit 2439